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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/971,524	11/17/97	KANTER R	RKPA1

IM71/1214

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EXAMINER
AHMAD, N

ART UNIT	PAPER NUMBER
1772	#2

DATE MAILED: 12/14/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
08/971,524	Kanter
Examiner	**Group Art Unit**
Nasser Ahmad	1772

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *three* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-15* is/are pending in the application.

Of the above, claim(s) *12-15* is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-11* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-11, drawn to a carpet assembly, classified in class 428, subclass 40.1.

   II. Claims 12-15, drawn to a method of manufacturing a carpet assembly, classified in class 156, subclass 72.

2. The inventions are distinct, each from the other because of the following reasons:

3. Inventions of Group II and of Group I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as using pressure sensitive adhesive, instead of contact cement, or the adhesive is applied to the bottom side of the carpet and then the foam mat is adhered thereto.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Mr. Morgan L. Crow on November 18, 1998 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 U.S.C. § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

7. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-2 and 4-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Wentworth (3,615,138).

Wentworth relates to a carpet assembly comprising a mat of closed cell foam composition having inherent shock absorbing properties, a layer of pressure sensitive adhesive (PSA) covering a mat surface, and a layer of carpet being fastened in contact with the PSA. The mat can be upto 0.5 inch thick (abstract). It is well known and conventional in the PSA art to provide a removable liner covering the PSA. Further, since claim 2 is directed to a step before the product as claimed in claim 1, it is not considered to be a positive limitation. Similarly, the phrase "for preventing injury" is directed to an intended use of the claimed product and is not a positive limitation.

Claim Rejections - 35 U.S.C. § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wentworth in view of Emerson (3,577,894).

Wentworth, as discussed above, fails to teach that the assembly comprises like sections secured contiguously together. Emerson discloses a carpet assembly with shock absorbing properties. the carpet assembly comprises like sections or strips that are joined together by adhesive tape or the like and laid over the entire court surface. The sections have suitable width or perimeter dimensions. As shown in Figure 2, the perimeter edge of the carpet assembly is provided with an edge molding. Emerson teaches the advantage of using adhesive tape to join like sections together thereby facilitating coverage of large areas. Therefore, it would have been obvious to one having ordinary skill in the art to utilize Emerson's teaching of using sections of carpet assembly joined together to form a covering for a large area in the invention of Wentworth.

It would have been obvious to one having ordinary skill in the art to modify Wentworth's mat to a thickness of 1.125 inch and Emerson's section dimension to 4 ft. wide by 6 ft. long based on optimization through routine experimentation.

11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wentworth in view of Emerson.

Wentworth and Emerson, as discussed above, fails to teach the presence of Velcro to secure like sections together. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Velcro, instead of adhesive, because the selection of any of these known equivalents would be within the level of ordinary skill in the art.

Claim Rejections - 35 U.S.C. § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

14. Claim 11 contains the trademark/trade name 3M Velcro®. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a hook and loop fastener product and, accordingly, the identification/description is indefinite.

15. Claim 10 is free of the prior art uncovered so far.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is (703) 308-4424. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ellis Robinson, can be reached on (703) 308-2364. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Nasser Ahmad

NASSER AHMAD
PRIMARY EXAMINER
~~GROUP 1300~~

Nasser Ahmad:cb
Patent Examiner

December 8, 1998
December 10, 1998